

Interim Waiver of Parts of 37 CFR 1.84 and 1.165, and  
Delay in the Enforcement of the Change in  
37 CFR 1.84(e) to No Longer Permit  
Mounting of Photographs

Photographs may be included in a patent application where photographs are the only practical medium for illustrating the claimed invention. Photographs are especially necessary in plant patent applications.

Effective November 29, 2000, 37 CFR 1.84(a)(2)(iii) and 1.165(b) were amended to require a black and white photocopy of any color drawing or photograph to permit the Office to make a black and white duplicate of the drawing or photograph for inclusion in any patent application publication or patent. Creation of a black and white copy is no longer considered necessary.

37 CFR 1.84(e) was also amended to require that photographs be developed on paper meeting the sheet size and margin requirements of the rule, thereby precluding mounting of photographs. This change was made because poorly mounted photographs frequently cause the photographs to separate from their mounting, and become lost. Many patent applicants were caught unprepared for this change, however, and have continued to file patent applications with mounted photographs. In order to permit these applications to be processed without requiring these applicants to obtain costly unmounted replacements and to allow applicants more time to explore alternative options (e.g., use of digital cameras or development options resulting in a digital image), the enforcement of this rule change will be delayed until October 1, 2001.

Lastly, 37 CFR 1.84(e) requires that drawings be made on non-shiny paper. By requiring drawings (including photographs) for plant patent applications to comply with 37 CFR 1.84, 37 CFR 1.165 suggests that plant patent photographs must not be shiny. Color photographs, however, generally have better color when produced with a shiny or gloss finish rather than a matte finish. As a result, the Office will not object to a standard photograph appearance, including a glossy or shiny finish.

In summary, the USPTO has sua sponte waived 37 CFR 1.84(a)(2)(iii) and 1.165(b) and is no longer requiring a black and white photocopy of any color drawing or photograph. In addition, mounted photographs will continue to be accepted until October 1, 2001. Lastly, 37 CFR 1.84(e) is also waived to the extent that no objections will be made to a photograph with a glossy or shiny finish. Any applicant who has received a requirement for: (1) a black and white photocopy of a color drawing or photograph, (2) a non-mounted photograph, or (3) a photograph without a shiny finish, may file a reply which indicates that such a requirement has been lifted together with a reference to this notice, or can supply the requested item(s).

Any questions or comments about this interim waiver of 37 CFR 1.84 and 1.165 as described above, and the delay in the enforcement of 37 CFR 1.84(e) to October 1, 2001, to no longer permit mounted photographs should be directed to Karin Tyson, Senior Legal Advisor, Office of Patent Legal Administration, Office of the Deputy Commissioner for Patent Examination Policy. Ms. Tyson can be reached by telephone at (703) 306-3159, or by e-mail at Karin.Tyson@uspto.gov.

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